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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,072	12/10/2003	Mark E. Tuttle	MI40-369	8908
21567	7590	09/08/2005	EXAMINER	
WELLS ST. JOHN P.S. 601 W. FIRST AVENUE, SUITE 1300 SPOKANE, WA 99201			EVERHART, CARIDAD	
			ART UNIT	PAPER NUMBER
			2891	

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/734,072	TUTTLE ET AL.	
	Examiner	Art Unit	
	Caridad M. Everhart	2891	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 39-101 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-19 is/are allowed.
- 6) ☒ Claim(s) 39-101 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 39-43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The recitation “no more than four sidewall surfaces that slope approximately linearly...” is not supported in the specification as originally filed.

Multiple Inventions

A restriction requirement was made in the original application dated 4/16/1999. The restriction required election between group I, claims 50-68, drawn to a semiconductor device and group II, claims 1-49, drawn to a process of making a semiconductor device. In the response to the restriction requirement filed 4-30-1999, applicant canceled claims 50-68, and elected the remaining claims. The reissue application adds new method of receiving a signal claims and new method of processing a signal claims in the amendment filed 8-15-05. The method of receiving a signal claims and the method of processing a signal claims are drawn to a separate invention, classified in class 455 subclass 95, .

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Claims 63-67 and 73-101 would have been restricted with respect to independent methods had the claims been presented in the original application. Claims 63-67 are drawn to a method of forming conductive film in a recess in which a chip has been provided. Claims 73-101 are drawn to a method of forming conductive material in a flexible plastic substrate in which there is provided a chip. These claims are to different and independent methods from the method claims presented in the original application, and would therefore have been restricted.

Claims 44-62, 63-67, and 68-72 and 73-101 are rejected under 35 USC 251 as attempting to correct an error not within the meaning of the reissue statute.

35 U.S.C. 251 particularly limits, through the "error" requirement, which types of errors are correctable by reissue. With respect to the correction of defects in claims, the patent must be "deemed wholly or partly inoperative or invalid...by reason of the patentee claiming more or less than he had a right to claim in the patent". No reissued claim can be obtained on subject matter which could not have been secured in the original patent. The issue is whether Applicant had a right to claim in the original patent what is now claimed in the reissue application. The Federal Circuit has adopted the previously established principle that applicants are "estopped from obtaining by reissue claims which, because of a requirement for restriction in which they had acquiesced, they could not claim in their patent." In *re* Watkinson, 900 F.2d 230,232, 14 USPQ2d 1407(Fed. Cir. 1990), quoting In *re* Orita, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977)(discussing In *re* Cornell, 150 F.2d 702,66 USPQ 320 (CCPA

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1945) and *In re Smyser*, 135 F.2d 747, 57 USPQ 402 (CCPA 1943)). See also *Weiler*, 790 F.2d at 1582, 229 UKSPQ at 677.

Applicant acquiesced to a restriction requirement by deliberately canceling all of the claims not directed to a method of manufacturing a radio frequency device in response to the requirement for restriction(S.N. 08/847,123, Amendment filed 4-30-1999, page 1). Appellant's "right to claim" was thereby limited to the elected method of manufacturing a radio frequency device.

It appears that if claims and 44-62 and 68-72 were presented during the prosecution of the '123 application, claims 44-62 and 68-72 would have been restricted out as being directed to a device/apparatus that would have been grouped with the non-elected invention(invention not belonging to elected group II). The main issue here is that the subject matter of claims 44-62 and 68-72 is independent and distinct from the subject matter of the elected and patented claims 1-18. Applicant would have had no right to examination and issuance of claims 44-62 and 68-72 in the original application after acquiescing to the restriction requirement. As indicated above, claims 63-67 and 73-101 would have been restricted with respect to species had the claims been presented in the original application.

Claims 1-18 of the patent are drawn to a method of making a radio frequency communication device, classified in class 438, subclass 19. The inventions are distinct, each from the other because the method of receiving a signal is independent from the method of making an antenna and as shown by their different classifications. Because these inventions are independent and distinct for the reasons given, these

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claims would have been withdrawn from consideration as being directed to a non-elected invention if they had been presented in the '123 application.

Allowable Subject Matter

Claims 1-19 are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Caridad M. Everhart whose telephone number is 571-272-1892. The examiner can normally be reached on Monday through Fridays 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, B. Baumeister can be reached on 571-272-1722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

C. Everhart
9-2-2005


CARIDAD EVERHART
PRIMARY EXAMINER